REMARKS

This responds to the Office Action dated December 1, 2004 and the Advisory Action dated March 1, 2005.

Claim 9 is amended. Claims 1-19 are pending in this application.

Information Disclosure Statement

In the Office Action, Examiner Evanisko indicated foreign patent EP-0452278A2 submitted with the Information Disclosure Statement, filed on September 24, 2004 would not be considered because the foreign patent EP-0452278A2 was not a complete copy. Applicant respectfully resubmits a copy of EP-0452278A2 herewith and further requests that a copy of the 1449 Form, initialed as having been considered by the Examiner, be returned to Applicants' Representative with the next Official communication.

Double Patenting Rejection

Claims 1-19 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-21 of U.S. Patent No. 6,097,986.

A terminal disclaimer is enclosed herewith to obviate the double patenting rejection. Reconsideration and allowance is respectfully requested.

§102 Rejection of the Claims

Claims 9-14 were rejected under 35 USC § 102(b) as being anticipated by Altman (U.S. Patent No. 5,551,427).

Applicant has amended claim 9 to better describe the subject matter recited in the claim. Applicant believes claim 9 is not anticipated by the cited reference since the reference does not include each limitation recited in the claim. For instance, Applicant cannot find in the cited reference a lead body including an electrode disposed along the lead body, the lead couplable to a pulse generator to deliver signals via the electrode, and an active fixation device disposed at a distal end of the lead body, the fixation device including an insulating material on at least a portion of its surface, the insulating material including an active ingredient. In contrast, Altman discusses a conductor and/or insulator device implanted into a heart to eliminate a portion of

tissue from the electrical field within the heart. (Abstract). Altman does not discuss a lead which can be coupled to a pulse generator to deliver signals.

Claims 10-14 include each limitation of claim 9 and are therefore also not anticipated by the cited reference.

Claims 9, 13, and 14 were rejected under 35 USC § 102(e) as being anticipated by Hoffmann et al. (U.S. Patent No. 5,902,329). Applicant notes that the Hoffman reference is a reference under 102(e) and Applicant reserves the right to swear behind the reference.

Applicant believes claim 9 is not anticipated by the cited reference since the reference does not include each limitation recited in the claim. For instance, Applicant cannot find in the cited reference an active fixation device disposed at a distal end of the lead body, the fixation device including an insulating material on at least a portion of its surface, the insulating material including an active ingredient. In contrast, Hoffman discusses a coating of hydrogel 30 on passive fixation tines 20.

Claims 13-14 include each limitation of claim 9 and are therefore also not anticipated by the cited reference.

§103 Rejection of the Claims

Claims 1-5 and 7-19 were rejected under 35 USC § 103(a) as being unpatentable over Bisping (U.S. Patent No. 4,886,074).

Claims 1-5, 7 and 8

Applicant respectfully traverses the single reference rejection under 35 U.S.C. § 103 since not all of the recited elements of the claims are found the cited reference. For instance, Applicant cannot find in the cited reference a mesh screen disposed at a distal end of the electrode tip or a fixation device including an insulating material on at least a portion of its surface, the insulating material including an active ingredient, as recited in claim 1.

Since all the elements of the claim are not found in the reference, Applicant assumes that the Examiner is taking official notice of the missing elements. Applicant respectfully objects to the taking of Official Notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests

that the Examiner cite references in support of this position. Absent a reference, it appears that the Examiner is using personal knowledge, so the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

Moreover, Applicant believes the Office Action has provided insufficient motivation to modify the cited reference. Applicant notes that the mere fact that a reference can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

Claims 2-5, 7, and 8 include each limitation of claim 1 and are therefore also not obvious in view of the cited reference. Reconsideration and allowance is respectfully requested.

Claims 9-15

Applicant respectfully traverses the single reference rejection under 35 U.S.C. § 103 since not all of the recited elements of the claims are found the cited reference. For instance, Applicant cannot find in the cited reference a fixation device including an insulating material on at least a portion of its surface, the insulating material including an active ingredient, as recited in claim 9.

Since all the elements of the claim are not found in the reference, Applicant assumes that the Examiner is taking official notice of the missing elements. Applicant respectfully objects to the taking of Official Notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position. Absent a reference, it appears that the Examiner is using personal knowledge, so the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

Moreover, Applicant believes the Office Action has provided insufficient motivation to modify the cited reference. Applicant notes that the mere fact that a reference can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

Claims 10-15 include each limitation of claim 9 and are therefore also not obvious in view of the cited reference. Reconsideration and allowance is respectfully requested.

Claims 16-19

Applicant respectfully traverses the single reference rejection under 35 U.S.C. § 103 since not all of the recited elements of the claims are found the cited reference. For instance, Applicant cannot find in the cited reference a mesh screen disposed at a distal end of the electrode tip or a fixation device including an insulating material on at least a portion of its surface, the insulating material including an active ingredient, as recited in claim 16.

Since all the elements of the claim are not found in the reference, Applicant assumes that the Examiner is taking official notice of the missing elements. Applicant respectfully objects to the taking of Official Notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position. Absent a reference, it appears that the Examiner is using personal knowledge, so the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

Moreover, Applicant believes the Office Action has provided insufficient motivation to modify the cited reference. Applicant notes that the mere fact that a reference can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

Claims 17-19 include each limitation of claim 16 and are therefore also not obvious in view of the cited reference. Reconsideration and allowance is respectfully requested.

Claims 1, 2, 3, and 7-19 were rejected under 35 USC § 103(a) as being unpatentable over Grassi (U.S. Patent No. 4,624,265).

Claims 1, 2, 3, 7 and 8

Applicant respectfully traverses the single reference rejection under 35 U.S.C. § 103 since not all of the recited elements of the claims are found the cited reference. For instance, Applicant cannot find in the cited reference a mesh screen disposed at a distal end of the

electrode tip or a fixation device including an insulating material on at least a portion of its surface, the insulating material including an active ingredient, as recited in claim 1.

Since all the elements of the claim are not found in the reference, Applicant assumes that the Examiner is taking official notice of the missing elements. Applicant respectfully objects to the taking of Official Notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position. Absent a reference, it appears that the Examiner is using personal knowledge, so the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

Moreover, Applicant believes the Office Action has provided insufficient motivation to modify the cited reference. Applicant notes that the mere fact that a reference can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

Claims 2, 3, 7, and 8 include each limitation of claim 1 and are therefore also not obvious in view of the cited reference. Reconsideration and allowance is respectfully requested.

Claims 9-15

Applicant respectfully traverses the single reference rejection under 35 U.S.C. § 103 since not all of the recited elements of the claims are found the cited reference. For instance, Applicant cannot find in the cited reference a fixation device including an insulating material on at least a portion of its surface, the insulating material including an active ingredient, as recited in claim 9.

Since all the elements of the claim are not found in the reference, Applicant assumes that the Examiner is taking official notice of the missing elements. Applicant respectfully objects to the taking of Official Notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position. Absent a reference, it appears that the Examiner is using personal knowledge, so the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

Moreover, Applicant believes the Office Action has provided insufficient motivation to modify the cited reference. Applicant notes that the mere fact that a reference can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

Claims 10-15 include each limitation of claim 9 and are therefore also not obvious in view of the cited reference. Reconsideration and allowance is respectfully requested.

Claims 16-19

Applicant respectfully traverses the single reference rejection under 35 U.S.C. § 103 since not all of the recited elements of the claims are found the cited reference. For instance, Applicant cannot find in the cited reference a mesh screen disposed at a distal end of the electrode tip or a fixation device including an insulating material on at least a portion of its surface, the insulating material including an active ingredient, as recited in claim 16.

Since all the elements of the claim are not found in the reference, Applicant assumes that the Examiner is taking official notice of the missing elements. Applicant respectfully objects to the taking of Official Notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position. Absent a reference, it appears that the Examiner is using personal knowledge, so the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

Moreover, Applicant believes the Office Action has provided insufficient motivation to modify the cited reference. Applicant notes that the mere fact that a reference can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

Claims 17-19 include each limitation of claim 16 and are therefore also not obvious in view of the cited reference. Reconsideration and allowance is respectfully requested.

Claims 4 and 5 were rejected under 35 USC § 103(a) as being unpatentable over Grassi (U.S. Patent No. 4,624,265).

Applicant respectfully traverses the single reference rejection under 35 U.S.C. § 103 since not all of the recited elements of the claims are found the cited reference. For instance, Applicant cannot find in the cited reference: wherein the piston has a slot therein, and the base further comprises a knob, said slot for mating with said knob, as recited in claim 4; or wherein the slot is mated with said knob to form a stop mechanism for said fixation device, as recited in claim 5.

Since all the elements of the claim are not found in the reference, Applicant assumes that the Examiner is taking official notice of the missing elements. Applicant respectfully objects to the taking of Official Notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position. Absent a reference, it appears that the Examiner is using personal knowledge, so the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2). Reconsideration and allowance is respectfully requested.

Claims 1-19 were rejected under 35 USC § 103(a) as being unpatentable over Janke et al. (U.S. Patent No. 6,097,986). The 6,097,986 patent issued after the filing date of present application and is therefore prior art to the present application, if at all, only under 35 U.S.C. 102(e). In view of the common ownership of the present application and the 6,097,986 patent as set forth below, applicant asserts that the latter is not prior art to the present application for purposes of 35 U.S.C. 103 and that the rejections of the claims on this basis have been overcome.

Statement of Common Ownership

Applicant declares that, at the time the present invention was made, the present application and U.S. Patent No. 6,097,986 were owned by the same entity. Since that patent could only otherwise qualify as prior art to the present application under 35 U.S.C. 102(e), it is disqualified as prior art for purposes of section 103(a) under 35 U.S.C. 103(c).

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 359-3267 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

AARON W. JANKE ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 359-3267

Date 6/01/05

By _____
Peter C. Maki
Reg. No. 42,832

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 1 day of June, 2005.

Paula Suchy
Name

Paula Suchy
Signature